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SERIAL NUMBER 067054,951	FILING DATE 04/27/93	FIRST NAMED INVENTOR CLEMENT	ATTORNEY DOCKET NO. J 26050111REI
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HASTINGS EXAMINER

ART UNIT 1303	PAPER NUMBER 7
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DATE MAILED: 06/01/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined

Responsive to communication filed on 3-8-94

This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1.  Notice of References Cited by Examiner, PTO-892.
2.  Notice re Patent Drawing, PTO-948.
3.  Notice of Art Cited by Applicant, PTO-1449.
4.  Notice of Informal Patent Application, Form PTO-152.
5.  Information on How to Effect Drawing Changes, PTO-1474.
6.

Part II SUMMARY OF ACTION

1.  Claims 1-18, 49-52 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims \_\_\_\_\_ have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims 1-18, 49-52 are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

EXAMINER'S ACTION

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This reissue application was filed without an offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect which is required. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before the reissue application can be allowed. See 37 C.F.R. § 1.178.

Claims 49-52 stand rejected under 35 U.S.C. § 251 as being broadened in a reissue application filed outside the two year statutory period.

New claim 49 is broader than the patent claims in many respects; claim 49

- 1) fails to specify "at room temperature in step (b)
- 2) fails to claim mechanical energy levels of steps (a) and (c) (1) and (c) (2)
- 3) fails to claim temperature range - (c) (1) and (c) (2)
- 4) fails to claim alkaline pH of at least 9 (c) (1) and (c) (2).

This broadening reissue is considered not to be timely filed since the parent reissue, SN. 07/600,012, was not a broadening reissue - SN 600,012 lacked basis for reissue because it was not for the invention disclosed in the original patent. Thus

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applicant cannot rely upon the filing date of SN 600,012 as being a broadening reissue filed within the two year statutory period. Also it is noted that by applicant's own admission in the oath, he did not discover this "error" until April 1993 - almost 5 years after the patent issued.

The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors relied upon, as required under 37 C.F.R. § 1.175(a)(5).

The reissue oath or declaration filed with this application is defective because it fails to particularly specify how the errors relied upon arose or occurred, as required under 37 C.F.R. § 1.175(a)(5).

The errors set forth by applicant are not errors correctable by reissue since applicant is attempting to recapture claimed subject matter deliberately narrowed by applicant during original prosecution in order to obtain the patent. See MPEP 1412.02 and Mentor Corp v. Coloplast Inc. CAFC 27 USPQ 2d 1521. Applicant during original prosecution, narrowed the claims to set forth specific mechanical energy levels, room temperature cleaning, and alkaline pH of at least 9 in order to overcome rejections made in that case. Applicant cannot now call these errors. It is not correctable by reissue. (applicant could have filed a

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continuation application to pursue claims of broader scope than those allowed in the original prosecution.) Note page 3 of the reply brief filed 6-1-92 in SN 600,012 even admits that the very specific process parameters of claim 1 were added during original prosecution in order to distinguish over the prior art.

Further the oath does not specify each change from the original patent claims as an error and how/why each error arose/occurred. Applicant fails, for example only, to discuss why specifying "at room temperature" for step (b) was an error. Each change represents acknowledgement of an error and must be referred to in the declaration. MPEP 1414, 1444.

Further, it does not seem that applicant can properly claim miscommunication difficulties because of his limited understanding of U.S. patent law as a reason for how the errors occurred. A lapse of almost five years from issuance of the original patent until applicant finally met and had "detailed review" of this situation with the attorneys of record in this case does not appear to be sufficient basis for how/why the errors arose which are the basis for reissue in this case.

Claims 1-18 and 49-52 stand rejected under 35 USC 251 as lacking basis for reissue, since recapture is not an error correctable by reissue. See above. Also, as stated in Hewlett

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Packard v Bausch & Lomb 11 USPQ 2d 1758, "reissue is not intended to give the patentee simply a second chance to prosecute the patent application... Section 251 does not authorize a patentee to re-present his application. Insight resulting from hindsight on the part of new counsel does not, in every case, establish error".

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and M.P.E.P. § 608.01(1). Correction of the following is required: the specification does not appear to explicitly describe the limitations of claims 1 and 50, re: below 50 KW.H/Ton, above 50 KW.H/Ton. The "below 50" and the range of 50-100 kWh/Ton for steps a, (c) (1) and (c) (2) were in original claims 3, 6 of the application 06/482,623, thus these limitations are not new matter, but it does appear the specification should be amended to provide proper basis for same.

Applicant's arguments filed 3-8-94 have been fully considered but they are not deemed to be persuasive.

Applicant argues that parent case SN 600,012 was a "broadening" reissue. The examiner disagrees. The examiner's position is that the parent reissue SN 600,012 lacked basis for reissue.

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The claims 19-48 of SN 600,012 were not for the invention disclosed in the original patent. In re Rowland 187 USPQ 487, Reissue applicants failure to timely file a divisional application is not considered to be an error causing a patent granted on elected claims to be partially inoperative by reason claiming less than they had a right to claim, thus applicants error is not correctable by reissue of the original patent under 35 USC 251 - See In re Orita et al 193 USPQ 145 In re Mead 198 USPQ 412.

In the original patent, restriction was required and applicant canceled the claims drawn to the invention of reissue claims 19-48. No matter what "communication difficulties and misunderstandings" applicant had with his attorneys, this situation ~~is~~ not correctable by reissue.

Paper No. 2 of grandparent 06/482,623 set forth in the original restriction requirements, paper no. 5 elected group 1 without traverse. The basis for the original restriction requirement was that the two groups recited mutually exclusive processing conditions. The examiners position is that the new claims 19-48 of SN 600,012 likewise recite mutually exclusive processing conditions from allowed claims 1-18 and were thus still properly restrictable.

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*did*

New claims 19-48 of parent 600,012 do not require any specific temperatures, pH's, shear forces (power inputs), consistencies, brightness, etc. Merely reciting high temperatures, high shear forces is not adequate to make these claims drawn to the same invention as patent claims 1-18. (Note "high" is relative and thus indefinite in any event). Thus claims 1-18 of 600,012 (Group I) require use of specific temperatures, power inputs, time limits, pHs, consistencies, brightness values, etc. processing conditions while claims 19-48 (Group II) do not require these conditions but do require steps of producing two pulps, recycle, etc. that are not required by Group I. Thus the two Groups are clearly drawn to mutually exclusive processing conditions, and are properly restrictable from one another. This situation cannot be corrected by reissue.

Thus SN 600,012 cannot be considered to have been a broadening reissue filed within two years. It is of no moment if claims 19-48 of 600,012 were disclosed in the '179 patent. The claims 19-48 of 600,012 lacked basis for reissue. The case law cited by applicant on pages 2, 3 of their remarks do not address this specific situation.

Applicant argues the recapture rule does not apply because there is no evidence that the amendments were in any sense an

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admission that the scope of the claims was not patentable. This argument is not persuasive because applicant even admitted that the very specific process parameters of claim 1 were added during original prosecution in order to distinguish over the prior art (page 3 of reply brief filed 6-1-92 in SN 600,012).

Applicant fail to address the deficiencies in the reissue oath set forth in the last Office action and repeated herein. With respect to applicant's comments on page 4 regarding antecedent basis in the specification for mechanical energy ranges; yes, this is a specific requirement, unless applicant can point out where these specific energy requirements are described in the specification.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed

Serial No. 08/054, 951

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to Exr. Hastings at telephone number (703) 308-0470.

  
KAREN M. HASTINGS  
PRIMARY EXAMINER  
ART UNIT 133

Exr. Hastings; nrd  
May 23, 1994

